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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/332,050	06/14/1999	JAN HOLLER	2466-29	2451

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EXAMINER

NGUYEN, STEVEN H D

ART UNIT	PAPER NUMBER
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2665

DATE MAILED: 08/12/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

09/332,050

Applicant(s)

HOLLER ET AL.

Examiner

Steven HD Nguyen

Art Unit

2665

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 May 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 11.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 4 and 14-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duault (USP 5600641) in view of Hiller (WO 9517789).

Duault discloses (Fig 1-16 and col. 1, lines 10 to col. 18, lines 47) a system comprising means connected to the ATM network for identifying a telephone call which enters the ATM network at an entry port (Fig 4, SW-1), means for identifying an exit port in the ATM network through which the call is to exit (Fig 5, Ref CP-1 identifies the exit port and forward the setup message to CP-2), and means for emulating a switch which provides synchronous transfer mode (STM) resources for a virtual STM connection the STM connection being used for returning an address of the exit port to the entry port, or for forwarding an address of the entry port to the exit port, whereby the call can be switched directly through the ATM network (Fig 5, CES-3 is used to return the address of the exit port to the entry port by ACK message such lable for using to switch the voice directly through ATM network); See col. 4, lines 52 to col. 5, lines 44; a narrowband switch in the call services network which, upon receipt of a call setup message, requests at least a first of plural virtual trunks necessary for reaching a bearer services network exit port (Col. 7, lines 55 to col. 8, lines 10); plural switch emulators which seize the plural virtual trunks for establishing an emulated connection between a bearer services network entry

Art Unit: 2665

port and the bearer services network exit port, the emulated connection being used for sending information to the bearer services network entry port so that a physical connection can be established through the bearer services network (Fig 5, Ref CP-1 and CES used to size the trunks for establishing a path between the entry and exist port) as claimed 14-16, 22-23 and 36; each switch has an emulator server (Fig 5) as claimed 17-18 and 29-30; the voice call is transparently transmitted via ATM (Fig 5) as claimed 19 and 31; a logical unit connected (Fig 4, Ref PA-A and SW) between the plural narrowband switches and the bearer services network , the logical unit emulating a virtual connection provided to the narrowband switches, the logical unit also returning over the virtual connection, to a bearer services network entry port, information so that a physical connection can be established through the bearer services network (PA-A used to emulating voice circuit to transmitting via ATM network) as claimed 24-28 and 34-35.

However, Duault does not fully disclose an IWU for using connecting between a narrowband and broadband network. In the same field of endeavor, Hiller discloses (Figs 1-46 and Page 1-80) an IWU for using connecting between an narrowband and broadband network which is emulating the voice call to ATM network (Fig 34-41 and 23 wherein the ATMU which is used to interface between NB and BB network).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply an ATM for interfacing between the broadband and narrowband for emulating a voice circuit call onto the ATM network as disclosed by Hiller's system onto Duault's system. The motivation would have been to reduce the delay of voice call.

Art Unit: 2665

3. Claims 2, 6-11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hiller and Duault as applied to claims 1, 4 and 36 above, and further in view of Doshi (USP 5568475).

Regarding claims 2 and 6-7, Duault and Hiller fail to disclose fully the claimed invention. However, in the same field of endeavor, Doshi discloses a means connected to the means for identifying the exit port and to an STM switch for emulating an STM connection to the STM switch (Fig 1, Ref 225) and information for call identification is sent together with the address in order to correlate the address with the call (Col. 5, lines 1-19, the dialed number is used to identify address of output port) and a unit for emulating a STM connection to a narrowband switch connected to a telecommunication network (Fig 6, Ref 245 and 255 or Fig 1, 210) comprising an ATM network comprising means for storing path requests received from the narrowband switch, means for acknowledging paths requests to the narrowband switch, and means for associating an incoming port with an outgoing port (Fig 6, Ref 255 or Fig 1, Ref 210 receives a call setup request from a narrowband switch telephone 25 and replies call setup request to the narrowband switch 25 and associating the incoming trunk with outgoing trunk in routing table; Col. 7, lines 31-63).

Regarding claims 8-10, Duault, Hiller and Doshi fail to fully disclose the claimed invention. However, the examiner takes an official noticed that a means for contacting broadband terminals connected to the telecommunication network; means for sending the address of one broadband terminal which includes the ATM End System Address (AESA) to another broadband terminal connected to the same network are well known and expected in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the

Art Unit: 2665

invention was made to apply a means for contacting broadband terminals connected to the telecommunication network; means for sending the address of one broadband terminal which includes the ATM End System Address (AESAs) to another broadband terminal connected to the same network to the ATM network of Duault, Hiller and Doshi. The motivation would have been to utilize ATM network.

Regarding claims 11 and 13, Duault and Hiller fail to fully disclose the claimed invention. However, Doshi discloses information for call identification is sent together with the address in order to correlate the address with the call (Col. 5, lines 1-19, the dialed number is used to identify address of output port).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply Doshi's teach into Duault's system. The motivation would have been to reduce delay of the voice call.

4. Claims 3, 5 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duault and Hiller/Doshi as claims 1, 4, 36 and further in view of Nakagaki (USP 5452295).

Regarding claims 3, 5 and 12, Duault fail to disclose the claimed invention. However, Nakagaki discloses means for establishing a new switched connection through the ATM network for each new telephone call by using ATM signaling and means for deciding if an already existing connection via the ATM network is to be used or if a new ATM connection is to be established (Fig 12, the telephone call is setup by ATM signaling and determined that if the old connect is disconnected by timer or not if yes establishing a new connection).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a method for setup a telephone call via ATM network by using

Art Unit: 2665

ATM signaling and determined if an old connection existed or not as disclosed by Nakagaki's system into the system of Duault/Doshi. The motivation would have been to allocate a band for a telephone call.

***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven HD Nguyen whose telephone number is (703) 308-8848. The examiner can normally be reached on 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy D Vu can be reached on (703) 308-6602. The fax phone numbers for the

Art Unit: 2665

organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

A handwritten signature in black ink, appearing to read 'Steven HD Nguyen', with a long horizontal line extending to the right.

Steven HD Nguyen  
Examiner  
Art Unit 2665  
August 7, 2003